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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,498	01/30/2002	Jong-Gu Park	57354-00002	5213
7590	11/08/2005		EXAMINER SCHULTZ, JAMES	
JHK Law P.O. Box 1078 La Canada, CA 91012-1078			ART UNIT 1635	PAPER NUMBER

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/066,498

Applicant(s)

PARK ET AL.

Examiner

J. D. Schultz, Ph.D.

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 30-39, 46, 47 and 50-59, 62 and 63 under 35 U.S.C. 103(a), for reasons of record.
- Claim(s) withdrawn from consideration: 12-19, 24-29, 40 and 43-47.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

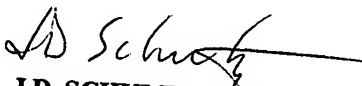
REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments, which were previously not considered to be convincing, are essentially reiterated and are still considered unconvincing. Applicants argue numerous points that have been addressed in the final action mailed 13 July 2005. Briefly, applicants argue that the primary reference of Hellmann does not teach putting his large circular antisense construct into a transfection carrier, because Hellmann uses a cell free assay. Applicants assert therefore that Hellmann cannot be combined with teachings of Moon, who teaches circular antisense compositions comprising transfection carriers, because one of ordinary skill looking at Hellmann's cell free system would not look to Moon for guidance. This is simply a matter of disagreement. It is maintained that one of ordinary skill in the antisense art, looking at the use of large, circular single stranded antisense compositions in a cell free system, would instantly understand that going from a cell free to a cell-based use of such molecules is a very small step, a step which is done routinely in the antisense arts, as evidenced by Moon, and LaPlante and Gewirtz. The assertion that these are not analogous art is simply in error, since each prior art reference deals with antisense mediated inhibition of gene expression. Applicants indication that the 116mer of Moon is considered by Moon to be "relatively large" is actually considered supportive of a reasonable expectation of success, since the indication is that it should "not be a problem". When combined with the teachings of LaPlante, who shows transfection of plasmids larger than the size of applicants compounds, one of ordinary skill in the art would not doubt that there is a sufficiently reasonable expectation of success in achieving high levels of transfection.

Applicant's arguments that they were the first to use the compounds of the prior art (Hellmann) to demonstrate gene ablation in cells is agreed with. However, the instant rejection is based on obviousness, which results from determining what the teachings of the prior art would suggest to one of ordinary skill, rather than a rejection under 35 U.S.C. § 102 for anticipation. Applicants have focused on how one of ordinary skill would not look to the antisense oligo art teaching the use of transfection effective carriers and conclude that large circular antisense could also be put into transfection effective carriers. However, it is important to note that the cited art indicates that antisense of all types have been put into carrier compositions; from Moon's circular antisense compounds, to the full length antisense plasmids of LaPlante, to the antisense oligonucleotides of Gewirtz, who teaches how the antisense art in general has been very focused on the importance of using transfection agents when trying to accomplish antisense-mediated inhibition of expression. Since the large circular antisense compounds themselves were known via Hellmann, and since multiple cited references teach that it is obvious to combine antisense molecules of many varieties such as circular (Moon et al.), full length (LaPlante et al.), and antisense oligos (Gewirtz et al.) with transfection agents, it is considered obvious to combine the large circular antisense of Hellmann with transfection agents as taught by Gewirtz, LaPlante, and Moon.

Applicants have argued that all antisense molecules cannot be lumped into a single group. They have not. As indicated herein, art has been cited relating to large circular antisense molecules, antisense oligos, plasmids encoding antisense oligos and smaller circular antisense molecules, the last three of which all teach the use of transfection carriers. Thus, the assertions that large circular molecules behave differently is not considered to be relevant, since art has been cited teaching that such molecules can be effectively transfected, and since Hellmann teaches that such molecules can be used to inhibit gene expression. Finally, the evidence pertaining to the publication provided after final will not be considered, since no indication has been provided why it is necessary and was not presented earlier when prosecution was ongoing. However, it is noted that such evidence might be helpful in ascertaining whether there are unexpected results that might arise from the practice of the present invention.


J.D. SCHULTZ, Ph.D.
PATENT EXAMINER